

## **REMARKS**

The Office Action of July 9, 2004, has been received and reviewed.

Claims 12-16 and 24-37 are currently pending and under consideration in the above-referenced application, each standing rejected.

Reconsideration of the above-referenced application is respectfully requested.

### **Examiner's Interview**

In an Examiner's Interview that was conducted on June 15, 2004, a variety features that distinguish the claims of the above-referenced application from the prior art were discussed, as was the commercial success of products that fall within the scope of the claims and the long-felt need for such apparatus in the art.

### **Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 16, 30, and 37 have been rejected for reciting subject matter which is purportedly indefinite. Specifically, each of these claims stands rejected for reciting "said biasing element," a claim element which lacks proper antecedent basis in the claims.

Each of claims 16, 30, and 37 has been amended to replace the recitation "said biasing element is" with "said handles are," a claim element for which proper antecedent basis is provided by independent claims 1, 25, and 31, respectively.

As each of claims 16, 30, and 37 now complies with the definiteness requirement of 35 U.S.C. § 112, second paragraph, it is respectfully requested that the section 112, second paragraph, rejections of these claims be withdrawn.

### **Rejections Under 35 U.S.C. § 102**

Claims 12, 13, 16, 24-28, 30-35, and 37 stand rejected under 35 U.S.C. § 102(b) for being drawn to subject matter which is allegedly anticipated by the subject matter described in U.S. Patent 5,617,785 to Lo (hereinafter "Lo").

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under

35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Lo describes an embossing apparatus that may be manually or automatically operated. The embossing apparatus of Lo includes two magnets 40 and 60 with opposed surfaces that appear to include substantially planar central sections and recessed ridges about the peripheries of the surfaces. *See* FIGs. 5 and 6. Movement of the lower magnet 60 toward the upper magnet 40 may be effected automatically with a motor 71-driven transmission 70 and a variety of associated elements, including spindles 72, 75 and gears 73, 74. Col. 3, lines 1-23; FIGs. 5 and 6. Movement of the upper magnet 40 toward the lower magnet 60 may be effected manually, by use of a gear 56 or a handle 120. Col. 3, lines 24-45; FIGs. 5 and 6.

Independent claim 12 recites an apparatus for forcing a die into a sheet of material. The apparatus of independent claim 12 includes first and second members and handles that are associated with the first and second members. The first member includes a die receiving surface, while the second member includes a planar, uninterrupted sheet supporting surface oriented to oppose the die receiving surface. The sheet supporting surface of the second member is uninterrupted and planar.

It is respectfully submitted that Lo does not anticipate at least three elements of independent claim 12.

First, Lo lacks any express or inherent description that either the upper magnet 40 or the lower magnet 60 thereof includes a surface that supports a sheet of material into which a die is to be forced. Rather, the description of Lo is limited to magnets 40 and 60 with surfaces that are respectively configured to engage a top die 80 and a bottom die 90. *See* FIG. 5; col. 3, lines 11-14.

Second, Lo neither expressly nor inherently describes that the apparatus disclosed therein includes handles associated with first and second members. Instead, Lo merely describes that a single handle 120 is associated with the upper, first magnet 40 of the disclosed apparatus.

Third, Lo includes no express or inherent description that the apparatus thereof includes a planar sheet supporting surface that is oriented to oppose a die receiving surface. Rather, in the device of Lo, a sheet is supported by an embossing die 90, which is clearly not planar.

As Lo does not expressly or inherently describe an apparatus which includes, in identical detail to that recited in independent claim 12, each and every element of independent claim 12, it is respectfully submitted that the subject matter recited in independent claim 12 is not anticipated by the disclosure of Lo under 35 U.S.C. § 102(b).

Claims 13, 16, and 24 are each allowable, among other reasons, for depending either directly or indirectly from claim 12, which is allowable.

Claim 16, as amended and presented herein, is further allowable since, in addition to lacking any express or inherent description of an apparatus that includes more than one handle, Lo lacks any express or inherent description that more than one handle may be configured to be held and operated with a single hand.

Independent claim 25 is also directed to an apparatus for forcing a die into a sheet of material. The apparatus of independent claim 25 includes first and second members, as well as handles associated with the first and second members. The first member of the apparatus of independent claim 25, as amended, includes a die receiving surface which is configured to receive and completely support a planar back side of a substantially planar die and a die retaining element associated with the die receiving surface. The second member of the apparatus of independent claim 25 includes a substantially planar sheet supporting surface

It is respectfully submitted that there are at least three reasons that the description of Lo does not anticipate each and every element of amended independent claim 25, as would be required to maintain the 35 U.S.C. § 102(b) rejection of independent claim 25.

First, it is respectfully submitted that Lo cannot anticipate both a die receiving surface which is configured to support a planar back side of a substantially planar die and which is configured to completely support the back side of the substantially planar die, as required by amended independent claim 25. This is because, as shown in FIGs. 5 and 6 of Lo, the die-supporting surfaces of both magnets 40 and 60 appear to include planar centers with recessed, or

stepped, peripheries. Additionally, as shown in FIGs. 5 and 6 of Lo, the upper and lower dies 80 and 90 have much larger diameters than the raised centers of the die-securing surfaces of the magnets 40 and 60, respectively. Consequently, if the back sides of the dies 80 and 90 are planar, they are not fully supported by the planar, central portions of the die-securing surfaces of the magnets 40 and 60, as required by amended independent claim 25. Conversely, if the back sides of the dies 80 and 90 are fully supported by the die-supporting surfaces of the magnets 40 and 60, the back sides of the dies 80 and 90 would have to include downward extensions at the outer peripheries thereof, and could not be planar, as required by amended independent claim 25.

Second, Lo does not expressly or inherently describe that either the upper magnet 40 or the lower magnet 60 thereof includes a surface that supports a sheet of material into which a die is to be forced. Rather, the description of Lo is limited to magnets 40 and 60 with surfaces that are respectively configured to engage a top die 80 and a bottom die 90. *See FIG. 5; col. 3, lines 11-14.*

Third, Lo neither expressly nor inherently describes that the apparatus disclosed therein includes handles associated with first and second members. Instead, Lo merely describes a single handle 120 that is associated with the upper, first magnet 40 of the disclosed apparatus.

Accordingly, it is respectfully submitted that, under 35 U.S.C. § 102(b), amended independent claim 25 is directed to subject matter which is allowable over that disclosed in Lo.

Each of claims 26-28 and 30 is allowable, among other reasons, for depending either directly or indirectly from claim 25, which is allowable.

Claim 30, as amended and presented herein, is further allowable since, in addition to lacking any express or inherent description of an apparatus that includes more than one handle, Lo lacks an express or inherent description that more than one handle may be configured to be held and operated with a single hand.

Like independent claims 12 and 25, independent claim 31 is also drawn to an apparatus for forcing a die into a sheet of material. The apparatus of independent claim 31 also includes first and second members and handles that are associated with the first and second members. The first member includes a planar die receiving surface and a die retaining element associated

therewith. The second member includes a sheet supporting surface oriented to oppose the die receiving surface of the first member. The handles of amended independent claim 31 facilitate movement of the first and second members toward one another.

It is respectfully submitted that there are at least three reasons that the subject matter to which amended independent claim 31 is drawn is not anticipated by the subject matter described in Lo.

First, it is respectfully submitted that Lo does not expressly or inherently describe that the apparatus disclosed therein includes a sheet supporting surface, as required by independent claim 31. Rather, the opposed surfaces of the two magnets 40 and 60 are both configured to have dies 80 and 90, respectively, secured thereto.

Second, it is respectfully submitted that Lo includes no express or inherent description of an apparatus that includes more than one handle, as recited in independent claim 31. Instead, the description of Lo is limited to an apparatus that includes a single handle 120 associated with only one of the magnets 40 thereof.

Third, it is respectfully submitted that Lo lacks any express or inherent description of an apparatus that includes handles that facilitate movement of first and second members toward one another. Instead, the sole handle 120 of the apparatus described in Lo only moves magnet 40; it does not move magnet 60. In fact, according to the disclosure of Lo, magnet 40 may only be moved manually, while magnet 60 may only be moved automatically, such as by use of the transmission 70 and the various elements that are associated therewith.

For these reasons, it is respectfully submitted that, under 35 U.S.C. § 102(b), the subject matter to which amended independent claim 31 is drawn is allowable over the subject matter disclosed in Lo.

Each of claims 32-35 and 37 is allowable, among other reasons, for depending directly from claim 31, which is allowable.

Claim 32, as amended and presented herein, is additionally allowable because Lo cannot teach or suggest a die receiving surface that is configured both to completely support a substantially planar die and to support a planar back side of a substantially planar die. Rather, the die-supporting surfaces of both magnets 40 and 60 of the apparatus disclosed in Lo appear to

include planar centers with recessed, or stepped, peripheries and the upper and lower dies 80 and 90 have much larger diameters than the raised centers of the die-securing surfaces of the magnets 40 and 60, respectively. As a result, if the back sides of the dies 80 and 90 are planar, they are not fully supported by the planar, central portions of the die-securing surfaces of the magnets 40 and 60, as required by amended independent claim 32. Conversely, if the back sides of the dies 80 and 90 are fully supported by the die-supporting surfaces of the magnets 40 and 60, the back sides of the dies 80 and 90 would have to include downward extensions at the outer peripheries thereof, and could not be planar, as required by amended independent claim 32.

Claim 37, as amended and presented herein, is further allowable since, in addition to lacking any express or inherent description of an apparatus that includes more than one handle, Lo lacks and express or inherent description that more than one handle may be configured to be held and operated with a single hand.

In view of the foregoing, withdrawal of the 35 U.S.C. § 102(b) rejections of claims 12, 13, 16, 24-28, 30-35, and 37 is respectfully requested.

#### **Rejections Under 35 U.S.C. § 103(a)**

Claims 14, 15, 29, and 36 are rejected under 35 U.S.C. § 103(a).

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Lo in View of Fink

Claim 14 has been rejected under 35 U.S.C. § 103(a) for being directed to subject matter which is purportedly unpatentable over the subject matter taught in Lo, in view of teachings from U.S. Patent 4,574,693 to Fink et al.

Claim 14 is allowable, among other reasons, for depending directly from claim 12, which is allowable.

Lo in View of Sabin

Claims 15, 29, and 36 stand rejected under 35 U.S.C. § 103(a) for reciting subject matter which is purportedly unpatentable over the teachings of Lo, in view of teachings from U.S. Patent 5,172,622 to Sabin.

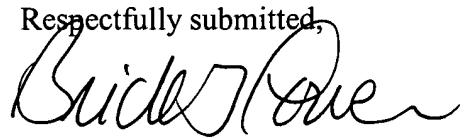
Claims 15, 29, and 36 are each allowable, among other reasons, for depending directly from claims 12, 25, and 31, respectively, each of which is allowable.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections of claims 14, 15, 29, and 36 is respectfully requested.

### CONCLUSION

It is respectfully submitted that each of claims 12-16 and 24-37 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



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